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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,865	01/09/2004	John Stewart	081557-0307579	6128

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EXAMINER

TRETTEL, MICHAEL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/753,865

Applicant(s)

STEWART ET AL.

Examiner

Michael Trettel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 25-48 is/are allowed.
- 6) ☒ Claim(s) 12, 13, 16, 17, 19 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 14, 15, 18, 20, 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 12, 13, 16, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tai (US 5,560,056). Tai shows a multiple use body support that broadly comprises an outer shell portion 1 that encloses an inflatable mattress 2. Shell 1 includes a mattress bag portion 10 which has a slide fastener Z for allowing access to the interior of the bag portion 10, and a sleeping bag portion 1a attached to the edges of the bag portion 10 to form an envelope for receiving a person upon the upper surface of the bag portion. Note that the sleeping bag cover portion 1a is shorter in overall length than the upper layer of the bag portion 10, as is shown in Figure 2. The air mattress 2 is formed in multiple hinged sections 21, 22, 23, and pillow portion 24, with the hinges allowing the mattress sections to be folded relative to one another. A fill vent 20 is coupled to the mattress 2. Hinges lines F1 and F2 correspond to the mattress hinges between sections 21, 22 and 22, 23. Note the various positions that can be assumed by the mattress sections shown in Figures 3 to 5. Each of the hinged sections can be folded relative to the next section, and need not be folded only in the manner explicitly shown by Tai. The structure shown by Tai shows all of the structural details claimed, the statements present in the "wherein" clauses of the claims can inherently be performed by the Tai device and do not define over the reference. This is because the statements present in the "wherein" clauses are no more than statements of intended use, i.e., they define how the device is intended to be used and not how it is formed.

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Note that the pillow portion 24 extends above the height of the remaining mattress sections 21, 22, and 23, and that the bag portion 10 includes a raised portion to receive the pillow portion. Also note that the interior of the bag portion 10 and the sleeping bag portion 1a can inherently serve as a means for storing the device in a rolled up condition.

Claim Rejections - 35 USC § 103

Claims 22 to 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tai (US 5,560,056) in view of Hsu (US 6,543,072). Hsu teaches that a sleeping bag apparatus can include a pillow portion 1 with a decorative image formed upon the upper surface. Note the details shown in Figure 1, in which the decorative element is coupled with three dimensional elements attached to the cover portion in order to enhance the effect of the decoration. It would have been obvious to one of ordinary skill in the art to have provided the sleeping bag apparatus with decorative elements as taught by Hsu, for the purpose of decorating the sleeping bag. Note that the use of any type of decorative image upon the bag cover or pillow cover can be considered to be a three dimensional shape, since the underlying bag or cover is three dimensional in shape.

Response to Arguments

Applicant's arguments filed April 22, 2005 have been fully considered but they are not persuasive.

The applicant's arguments with respect to claim 12 are unpersuasive. The arguments center solely upon the statements present within the "wherein" clauses set forth in claim 12,

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which statements are in the opinion of the examiner to be no more than statements of intended use. The intended use of the device does not define patentable subject matter, especially if the prior art shows a device that is inherently capable of fulfilling the intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). As regards the Tai reference, the applicant has argued that Tai could not perform the function set forth in the claims, since Tai uses a belt 3 and hook and loop fasteners tapes 11a, 12a to hold the device in the particular folded configurations shown in the reference. This argument is misleading, because it is not necessary to use the belt and fasteners in order to fold the Tai device along the hinge lines between the sections. Tai's mattress could be folded along the hinge lines in the fashion claimed since these components do not prevent folding the sections in the fashion claimed, and in addition there is no language present in the claims to preclude the existence of the belt and fastener tapes. Therefore the belt and fastener components shown in the Tai reference are irrelevant to the rejection at hand.

The amendments made to claim 25 and the arguments made regarding this claim and its dependents have been reviewed and are agreed with. The rejection to claim 25 has been dropped as a result.

As regards the rejection of claims 22 to 24 under §103, the arguments made do not specifically traverse the rejection but instead rely upon the arguments made against the §102 rejection over Tai. Since these arguments are unpersuasive the 103 rejection has been repeated.

Allowable Subject Matter

Claims 14, 15, 18, 20, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1 to 11 and 25 to 48 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

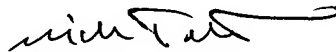
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Trettel whose telephone number is (571) 272-7052. The examiner can normally be reached on Monday, Tuesday, Thursday, or Friday from 7.30 am to 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (571) 272-7052. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Michael Trettel
Primary Examiner
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